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USSN: 08/844,336  
Atty. Dkt. No.: 9400-0005  
Client Dkt. No.: PXE.002.US

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re Application of:	Examiner: R. Zeman
CONTAG et al.	Group Art Unit: 1645
Serial No.: 08/844,336	Confirmation No.: 7227
Filing Date: April 18, 1997	Customer No.: 20855
Title: BIODETECTORS TARGETED TO SPECIFIC LIGANDS	

**TERMINAL DISCLAIMER UNDER 37 C.F.R. §1.321(b)**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

1. I, Dahna S. Pasternak, state that I am an attorney of record in the above-captioned application and am a representative authorized to sign this document on behalf of Xenogen Corporation, the assignee for this invention.

2. The assignee of record is Xenogen Corporation, having a place of business at 860 Atlantic Avenue, Alameda, CA, 94501.

3. The assignee is the owner of the entire right, title and interest in the invention disclosed and claimed in the above-captioned application, U.S. application serial no. 08/844,336, filed April 18, 1997, by virtue of an assignment recorded October 6, 1998 at Reel 9497, Frame 0636, and is also the owner of the entire right, title and interest in U.S. Patent No. 6,638,752, issued October 28, 2003, by virtue of the above assignment.

12/30/2003 HVUONG1 00000106 08844336

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4. In accordance with 37 C.F.R. §3.73(b), the undersigned hereby certifies that the evidentiary documents with respect to the assignee's ownership, copies of which are appended hereto, have been reviewed and that, to the best of his/her knowledge and belief, title is in the assignee seeking to take this action.

5. The assignee hereby disclaims the terminal part of any patent granted on the above-captioned application serial no. 08/844,336 which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §§ 154-156 and 173 of U.S. Patent No. 6,638,752, except as provided below, and agrees that any patent granted on the above-captioned application serial no. 08/844,336 will be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to U.S. Patent No. 6,638,752, this agreement to run with any patent granted on the above-captioned application serial no. 08/844,336 and to be binding upon the grantee, its successors or assigns.

6. In making this disclaimer, the assignee does not disclaim the terminal part of any patent granted on the above-captioned application serial no. 09/925,796 that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154-156 and 173 of U.S. Patent No. 6,638,752, in the event that it later (a) expires for failure to pay a maintenance fee, (b) is held unenforceable, (c) is found invalid by a court of competent jurisdiction, (d) is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, (e) has all claims cancelled by a reexamination certificate, (f) is reissued, or (g) is, in any manner, terminated prior to the expiration of its full statutory term.

7. The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16, 1.17 and 1.21 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 18-1648 (attorney docket no. 2300-1468).

Executed at Palo Alto, CA  
By: *Plastunah*  
Title: Attorney of Record  
Date: 12/22/03



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FEBRUARY 02, 1999

HOWREY & SIMON  
ALBERT P. HALLUIN  
BOX NO. 34  
1299 PENNSYLVANIA AVENUE, N.W.  
WASHINGTON, D.C. 20004-2402

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FEB 16 1999

HOWREY & SIMON

07953-0004-999  
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**NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT**

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PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 10/06/1998

REEL/FRAME: 9497/0636  
NUMBER OF PAGES: 5

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:  
CONTAG, PAMELA R.

DOC DATE: 09/18/1998

ASSIGNOR:  
BENARON, DAVID A.

DOC DATE: 09/22/1998

ASSIGNOR:  
CONTAG, CHRISTOPHER H.

DOC DATE: 09/18/1998

ASSIGNEE:  
XENOGEN CORPORATION  
860 ATLANTIC AVENUE  
ALAMEDA, CALIFORNIA 94501

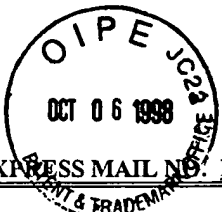
SERIAL NUMBER: 08844336  
PATENT NUMBER:

FILING DATE: 04/18/1997  
ISSUE DATE:

: 9497/0636 PAGE 2

LAWAN FLETCHER, EXAMINER  
ASSIGNMENT DIVISION  
OFFICE OF PUBLIC RECORDS

10-14-1998



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EXPRESS MAIL NO. EL185308985US

Attorney's Docket No. 07953.0004.999

Form PTO-1595  
6-93

U.S. Department of Commerce  
RECORDATION FORM COVER SHEET Patent and Trademark Office  
PATENTS ONLY

To the Honorable Commissioner of Patents and Trademarks. Please record the attached original documents or copy thereof.

## 1. Name of conveying party(ies):

Pamela R. Contag; David A. Benaron; and Christopher H. Contag

Additional name(s) of conveying party(ies) attached? ☐ yes ☒ no

## 2. Name and address of receiving party(ies):

Name: Xenogen Corporation

Street Address: 860 Atlantic Avenue

City: Alameda State: California Zip Code: 94501

Country: USA

Additional name(s) & address(es) attached? ☐ yes ☒ no

## 3. Nature of Conveyance:

- ☒ Assignment ☐ Merger  
☐ Security Agreement ☐ Change of Name  
☐ Other \_\_\_\_\_

Execution Date(s): September 18 and 22, 1998

## 4. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application is

A. Patent Application No(s). 08/844,336

B. Patent No(s).

Additional numbers attached? ☐ yes ☒ no

## 5. Name and address of party to whom correspondence concerning document should be mailed:

Name: HOWREY &amp; SIMON

Internal Address: Albert P. Halluin

Street Address: Box No. 34  
1299 Pennsylvania Ave, N.W.

City: Washington State: D.C. Zip Code: 20004-2402

## 6. Total number of applications and patents involved

17. Total fee (37 C.F.R. § 3.41).....\$ 40.00☒ Enclosed☐ Authorized to be charged to Deposit Account

## 8. Deposit Account Number: 08-3038

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## 9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Albert P. Halluin (Reg. No. 25,227)

Name of Person Signing

Registration No.

Signature

October 5, 1998

Date

Total number of pages including cover sheet, attachments and document 5

OMB NO. 0651-0011 (exp. 4/94)

10/14/1998 DNGUYEN 00000037 08044336

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Mail documents to be recorded with required cover sheet information to:  
 Commissioner of Patents and Trademarks, Box Assignments  
 Washington, D.C. 20231

## ASSIGNMENT

In consideration of the sum of One Dollar (\$1.00) or equivalent and other good and valuable consideration paid to each of the undersigned: **Pamela R. Contag; David A. Benaron; and Christopher H. Contag** the undersigned hereby sell(s) and assign(s) **Xenogen Corporation, 860 Atlantic Avenue, Alameda, California 94501, USA** (the Assignee) his/her entire right, title and interest

*check applicable box(es)* ☒: for the United States of America (as defined in 35 U.S.C. § 100),  
☒: and throughout the world,

in the invention(s) known as **BIODETECTORS TARGETED TO SPECIFIC LIGANDS** for which application(s) for patent in the United States of America has (have) been executed by the undersigned on **March 27, 1998** (also known as United States Application No. **08/844,336**, filed **April 18, 1997**), in any and all applications thereon, in any and all Letters Patent(s) therefor, and in any and all reissues, extensions, renewals, reexaminations of such applications or Letters Patent(s) and divisional and continuation applications thereof, to the full end of the term or terms for which such Letters Patent(s) issue, including all claims, if any, that may have arisen for infringement prior to the date of this assignment, such entire right, title and interest to be held and enjoyed by the above-named Assignee to the same extent as they would have been held and enjoyed by the undersigned had this assignment and sale not been made.

The undersigned agree(s) to execute all papers necessary in connection with the application(s) and any continuing (continuation, divisional, or continuation-in-part), reissue, reexamination or corresponding application(s) thereof and also to execute separate assignments in connection with such applications as the Assignee may deem necessary or expedient.

The undersigned agree(s) to execute all papers necessary in connection with any interference that may be declared concerning the application(s) or any continuing (continuation, divisional, or continuation-in-part), reissue or reexamination application thereof and to cooperate with the Assignee in every way possible in obtaining evidence and going forward with such interference.

The undersigned hereby represents that the undersigned has full right to convey the entire interest herein assigned, and that the undersigned has not executed, and will not execute, any agreement in conflict therewith.

The undersigned hereby grant(s)

Jeffrey I. Auerbach, Reg. No. 32,680  
Melvin L. Barnes, Jr. Reg. No. 38,375  
Thane Bauz, Reg. No. P41,604  
Michael J. Bell, Reg. No. 39,604  
John A. Bendrick, Reg. No. P41,612  
Mark R. Buscher, Reg. No. 35,006  
Celine T. Callahan, Reg. No. 34,301  
Cono A. Carrano, Reg. No. 39,623  
Joseph V. Colaianne, Reg. No. 39,948  
James F. Davis, Reg. No. 21,072  
Thomas M. Dunham, Reg. No. 39,965  
Joel M. Freed, Reg. No. 25,101  
Vernon Randall Gard, Reg. No. 33,886  
Alan M. Grimaldi, Reg. No. 26,599  
Alexander J. Hadjis, Reg. No. 36,540  
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Rouget F. Henschel, Reg. No. 39,221

Leslie L. Jacobs, Jr., Reg. No. 40,659  
Richard H. Kjeldgaard, Reg. No. 30,186  
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David R. Marsh, Reg. No. 41,408  
Kevin W. McCabe, Reg. No. 41,182  
Joseph A. Micallef, Reg. No. 39,772  
Anthony D. Miller, Reg. No. 34,394  
Karen L. Nicastro, Reg. No. 35,968  
Bradley J. Olson, Reg. No. 40,750  
Russell O. Paige, Reg. No. P40,758  
Andrew Y. Piatnicia, Reg. No. 40,772  
Andrea G. Reister, Reg. No. 36,253  
Stephen J. Rosenman, Reg. No. 29,209  
Timothy L. Scott, Reg. No. 37,931  
Anthony W. Shaw, Reg. No. 30,104  
J. David Smith, Reg. No. 39,839  
Michael J. Songer, Reg. No. 39,841

of HOWREY & SIMON, BOX NO. 34, 1299 PENNSYLVANIA Avenue, N.W., Washington, D.C. 20004-2402, power to insert in this Assignment any further identification that may be necessary or desirable in order to comply with the rules of the United States Patent and Trademark Office for recordation of this document.



IN WITNESS WHEREOF, executed by the undersigned on the date(s) opposite their name(s).

Date: \_\_\_\_\_ Signature of Inventor: \_\_\_\_\_

Pamela R. Contag

Date: 22 Sept 98 Signature of Inventor: \_\_\_\_\_

David A. Benaron

Date: \_\_\_\_\_ Signature of Inventor: \_\_\_\_\_

Christopher H. Contag

Date: \_\_\_\_\_ Signature of Inventor: \_\_\_\_\_

## ASSIGNMENT

In consideration of the sum of One Dollar (\$1.00) or equivalent and other good and valuable consideration paid to each of the undersigned: **Pamela R. Contag; David A. Benaron; and Christopher H. Contag** the undersigned hereby sell(s) and assign(s) **Xenogen Corporation, 860 Atlantic Avenue, Alameda, California 94501, USA** (the Assignee) his/her entire right, title and interest

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☒: and throughout the world,

in the invention(s) known as **BIODETECTORS TARGETED TO SPECIFIC LIGANDS** for which application(s) for patent in the United States of America has (have) been executed by the undersigned on **March 27, 1998** (also known as United States Application No. **08/844,336**, filed **April 18, 1997**), in any and all applications thereon, in any and all Letters Patent(s) therefor, and in any and all reissues, extensions, renewals, reexaminations of such applications or Letters Patent(s) and divisional and continuation applications thereof, to the full end of the term or terms for which such Letters Patent(s) issue, including all claims, if any, that may have arisen for infringement prior to the date of this assignment, such entire right, title and interest to be held and enjoyed by the above-named Assignee to the same extent as they would have been held and enjoyed by the undersigned had this assignment and sale not been made.

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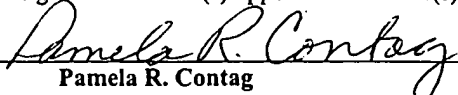
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Anthony W. Shaw, Reg. No. 30,104  
J. David Smith, Reg. No. 39,839  
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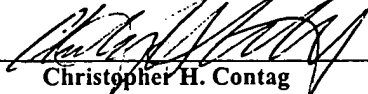
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IN WITNESS WHEREOF, executed by the undersigned on the date(s) opposite their name(s).

Date: 9/18/98 Signature of Inventor:   
Pamela R. Contag

Date: \_\_\_\_\_ Signature of Inventor: \_\_\_\_\_

David A. Benaron

Date: 9/19/98 Signature of Inventor:   
Christopher H. Contag

Date: \_\_\_\_\_ Signature of Inventor: \_\_\_\_\_